

Serial No. 09/976,418
Docket No. Brookstone 00.15
Amendment C under Rule 116

REMARKS

Claim 1 has been amended to incorporate the limitations of claim 19, which has been cancelled. Claim 20 has been similarly amended. Thus, all of the claims now require that the merchandising cart carry graphics or indicia. This feature is neither disclosed nor suggested by any of the art applied by the Examiner and, in fact, would be completely inappropriate in the case of Cook which has paper board side walls and rigid foam ends, or Jeffs et al. which relates to a cryogenic freezing vials which certainly would not be made of a transparent plastic since plastics become quite brittle at low temperatures.

Moreover, this distinction is more than merely academic. As noted in the second paragraph on page 7 of Applicant's specification, a feature and advantage of the present invention is that the container may function (1) as a shipping container without the need for extraneous packing material, (2) as a display container, i.e., for displaying the goods for sale; and (3) as an aftermarket storage container or coin bank.

Independent claims 1 and 20 also have been amended to clarify that the central portion is press-fit coupled to the first and second end caps. The primary reference, Gilbert, fixes his end blocks 11 to his central tube 10 by means of a threaded tie rod 14 and knob 20. Thus, the primary reference, Gilbert, and the secondary references, Cook and Jeffs et al., neither of which employ a tie rod are fundamentally different.

As the Examiner is well aware, MPEP §2143 requires that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

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reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)

Further, MPEP §2143.01 provides:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.' *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Following the MPEP, Cook and Gilbert, and Cook, Gilbert and Jeffs et al. are improperly combined to form the instant §103 rejections. As the Examiner states in cipher 2 of the Action, "Gilbert does not show [a] card situated with the caps..." Thus, the Examiner relies on Cook to supply the missing teaching.

However, Cook does not teach end caps that receive a merchandising card. In the instant reference, the Examiner asserts in cipher 2 (page 3) that "The Examiner is not relying on the shape of Cook's grooves for the combination, but the basic idea of providing any shape for the grooves to allow engagement of the card with the cap." Cook teaches using a molded top and

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bottom portion adapted to receive an article, for instance, glass tumblers, in a shipping container. The Examiner asserts that such grooves could be adapted to receive merchandising cards. Surely the Examiner is not suggesting the one skilled in the art would use the shipping container of Cook to ship containers having merchandising cards carrying graphics or indicia since Cook is formed of opaque materials.

Absent an explicit teaching of end caps adapted to receive a merchandising card in Cook, the Examiner must look for an implicit teaching, suggestion or motivation within the Cook and Gilbert references to determine whether these references can be combined to teach the features of claim 1. First of all, there would be no reason to combine Gilbert and Cook. Moreover, Gilbert relies on the combination of his end caps, the rod and rigid partition walls to support his thin flexible tube. Gilbert relates to a reusable container, having rigid side walls. As the Examiner states in cipher 2 of the Action, Gilbert does not show "[a] card situated within the cap."

Furthermore, Gilbert does not disclose a merchandising card, but a rigid cardboard structure adapted to both contain articles and provide rigidity to the container (col. 4, lines 1-15). Gilbert does not provide any suggestion that such card should be attached in the end pieces of the cap structure. In addition, Cook does not implicitly provide this teaching. Cook teaches a shipping container for shipping fragile products or products that are subject to damage if not protected (col. 1, lines 1-5). Cook is not concerned with merchandising cards attached between the top and bottom end caps, and there is no suggestion in Cook that recesses 20 and 24 of FIG. 3 could be modified to ship merchandising cards. Thus, the Examiner's combination of Cook and Gilbert could only be based upon hindsight reasoning, and no combination of Cook and Gilbert could render obvious the merchandizing card of claims 1 and 20, nor any claims dependent therefrom.

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As for the rejection of the claims under 35 USC §103 as obvious over Gilbert and Cook in further view of Jeffs et al. (U.S. Patent No. 5,711,466), and claims 11, 19 and 30 under 35 USC §103 as obvious over Gilbert and Cook in view of Official Notice, these claims are directly or indirectly dependent on claims 1 or 20 as the case maybe, and are patentable for the reasons adduced above, as well as for their own limitations. Moreover, Jeffs et al. clearly is non-analogous art. Jeffs et al. is concerned with a cryogenic freezing vial and includes a container for receiving directly biological samples. In rejecting the claims as obvious from Gilbert in view of Cook and further in view of Jeffs et al., the Examiner cites Jeffs et al. as "only cited to show a typical tube..." (paragraphs 3 and 6 of the Action). Jeffs et al. certainly cannot be said to be a "typical tube" but rather is a specially designed tube for use in cryogenic freezing of biological samples. One skilled in the art wanting to improve on shipping or merchandising containers would not look to the cryogenic art. It is therefore submitted the Examiner is employing impermissible hindsight by combining Gilbert, Cooks and Jeffs et al.

The foregoing Amendment makes no claim changes that would require further search. Thus, entry of the foregoing amendment and allowance of the application are respectfully requested.

Having dealt with all the objections raised by the Examiner, the Application is believed to be in order for allowance. Early and favorable action are respectfully requested.

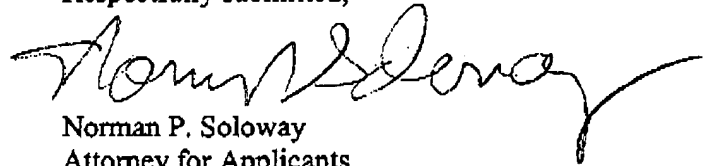
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In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.

Respectfully submitted,



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I hereby certify that this correspondence is being sent via facsimile to EXAMINER SHIAN TINH NHAN LUONG of the United States Patent and Trademark Office at facsimile number (703) 872-9303, on November 3, 2003 from Tucson, Arizona.

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